

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

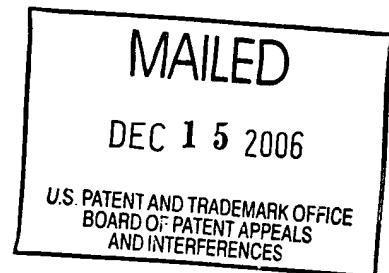
## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEVEN MAURICE SIKORSKI

Appeal No. 2006-3033  
Application No. 10/748,992

ON BRIEF



Before JERRY SMITH, SAADAT, and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-17.

### THE INVENTION

The disclosed invention pertains to an inverted terminal presentation scanner and holder.

Representative claims 1, 13 and 17 are illustrative:

1. A mobile device, comprising:

a display component; and

an orientation component that automatically orients display objects rendered by the display based at least in part upon a user perspective.

13. A method that facilitates displaying objects, comprising:

displaying graphical objects on a portable bar code scanning device;

automatically orientating rendered graphical objects based at least in part upon a physical orientation of a user with respect to the device; and

changing object display parameters to provide at least one of an optimized object display and an optimized viewing position.

17. A mobile scanning terminal system, comprising:

a data capture component that captures data;

a display that displays data to a user;

an artificial intelligence component that determines an optimal screen orientation for the display based at least upon a user's position; and

a holder that holds the data capture component at a predetermined position to allow for continuous and hands-free capture of data.

## **THE REFERENCES**

The examiner relies upon the following references:

Browning	6,707,581	Mar. 16, 2004
Manchester	US2004/0201595	(filed Jun. 27, 2000)
		Oct. 14, 2004
		(filed Apr. 11, 2003)

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Ogawa 6,937,281 Aug. 30, 2005  
(filed Oct. 10, 2000)

# THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1, 2, 5-7 and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Manchester.
2. Claims 3, 4, 8-12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Manchester in view of Browning.
3. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Browning in view of Manchester.
4. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Ogawa in view of Manchester.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

## OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our

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decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii) (2004). See also *In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of the claims on appeal. Accordingly, we affirm.

#### **GROUPING OF CLAIMS**

We consider the anticipation and obviousness of the following logical groups of claims, as defined under separate subheadings and argued separately by appellant in the briefs.

GROUP A: Claims 1, 2, 5-7 and 16 [brief, pages 4-7].

GROUP B: Claims 3, 4, 8-12 and 15 [brief, pages 7 and 8].

GROUP C: Claims 13 and 14 [brief, pages 8 and 9].

GROUP D: Claim 17 [brief, pages 9-11].

## **ANTICIPATION REJECTION**

In rejecting claims under 35 U.S.C. §102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation

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v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

**GROUP A**, claims 1, 2, 5-7 and 16

We consider first the examiner’s rejection of claims 1, 2, 5-7 and 16 as being anticipated by Manchester. Since appellant’s arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellant asserts that Manchester does not teach an orientation component that automatically orients display objects rendered by the display based at least in part upon a user perspective, as claimed [brief, page 6]. The examiner disagrees [answer, page 12]. The examiner argues that Manchester’s display image orients itself based on the user’s perspective since the user holds the display toward him/herself in order to view the

display [id.].

Appellant further asserts in the reply brief that there is nothing in Manchester that can accommodate any variations in the user's orientation [reply brief, page 2, cont'd page 3].

At the outset, we note that appellant's arguments are directed toward a first exemplary embodiment of Manchester's invention where a monitor automatically orients the display image provided by the monitor according to the physical orientation of the monitor [¶ 0019]. However, we note that an alternate embodiment of Manchester's invention can sense the physical orientation of "objects" where an "object" to be sensed broadly encompasses not only a display device, but also a person [page 2, ¶0019]. In particular, we note that Manchester explicitly discloses sensor 16 is capable of sensing the orientation of a display device and/or the orientation of a person viewing the display device [¶0021]. Significantly, we note that Manchester further discloses that three-dimensional display image 14 is oriented to provide a desired perspective to the viewer (i.e., a "user perspective") that may be accomplished by the viewing person "simply turning and/or shifting her head to view the desired perspective" [¶0028]:

[0028] In another embodiment, the three dimensional display image 14 is oriented to provide a desired perspective to the viewer. This may be accomplished by the viewer simply turning

and/or shifting her head to view the desired perspective, turning the display device 12 to view the desired perspective, or a combination thereof. As explained in more detail below, sensors 16 can be positioned on the viewer 36 and/or on the display device 12 to sense the orientation of the viewer and/or display device 12. For example, assume the three dimensional display image 14 is a cube and the display device 12 is a hand held display device. Also assume the viewer is viewing a front side of the cube. If the viewer desires to view the left side of the cube, she may simply rotate the hand held display device (e.g., to the right) to view the left side of the cube. She may also turn her head (e.g., to the right and/or shift her head to the left), as if the cube were physically in front of her and she positioned herself to look at the left side [emphasis added].

Therefore, we find that Manchester explicitly teaches an orientation component that automatically orients display objects rendered by the display based at least in part upon a user perspective, as claimed [claim 1]. Accordingly, because Manchester teaches all that is claimed, we will sustain the examiner's rejection of representative claim 1 as being anticipated by Manchester. With respect to independent claim 16, we note that appellant merely argues: "independent claim 16 recites system features in accordance with the subject innovation" [brief, page 5]. Therefore, we will sustain the rejection of claim 16 as being anticipated by Manchester for the same reasons discussed supra with respect to representative claim 1. We further note that appellant has not presented any substantive arguments directed separately to the patentability of dependent claims 2 and 5-7. See

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In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner's rejection of these claims as being anticipated by Manchester for the same reasons set forth in the rejection.

### **OBVIOUSNESS REJECTIONS**

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus

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the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038,

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1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

**Group B**, claims 3, 4, 8-12 and 15

We consider next the examiner's rejection of claims 3, 4, 8-12 and 15 as being unpatentable over the teachings of Manchester in view of Browning. Since appellant's arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 15 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellant argues that Browning fails to make up for the previously argued deficiencies of Manchester [brief, page 7]. Appellant further argues that Browning does not teach nor suggest an orientation component that automatically orients display objects rendered by the display based on at least in part a user perspective [brief, page 7, cont'd page 8]. Appellant argues that Browning does not relate to altering the orientation of displayed objects and therefore teaches away from the instant claimed invention [brief, page 8].

The examiner disagrees, noting that Manchester is relied on as teaching these limitations [answer, page 13].

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We do not find persuasive appellant's assertion that Browning teaches away from the instant claimed invention. We note that the examiner relies upon Browning for its disclosure of a scanner incorporated within personal digital assistant (PDA) 10 that includes a display 22 for displaying graphical objects [answer, page 6; see also Browning, fig. 1, col. 2, lines 52 and 53]. We further note that Browning's PDA 10 functions (in one embodiment) as a handheld barcode scanner [col. 3, lines 20-24]. Therefore, we agree with the examiner that the language of representative claim 15 (i.e., "capturing an image for further analysis") broadly but reasonably reads on Browning's barcode scanner 10. Accordingly, we will sustain the examiner's rejection of representative claim 15 as being obvious over Manchester in view of Browning.

We further note that appellant has not presented any substantive arguments directed separately to the patentability of dependent claims 3, 4 and 8-12. See In re Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528. See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner's rejection of these claims as being obvious over Manchester in view of Browning for the same reasons set forth in the rejection.

In addition, with respect to dependent claim 3, we find that the mere arrangement of "product information" data in the instant claimed "data

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store" constitutes nonfunctional descriptive material wherein the meaning of the data is functionally insignificant to the structure of the data store. The examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate (in this case the underlying structure of the data store).

See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).

**Group C**, claims 13 and 14

We consider next the examiner's rejection of claims 13 and 14 as being unpatentable over the teachings of Browning in view of Manchester. Since appellant's arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 13 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellant argues that neither Browning nor Manchester teaches or suggests the following limitations of representative claim 13 [brief, page 8]:

- §. automatically orientating rendered graphical objects based at least in part upon a physical orientation of a user with respect to the device; and

çI. changing object display parameters to provide at least one of an optimized object display and an optimized viewing position.

Appellant further argues that Manchester relates to changing the orientation of a displayed object based on properties of the object [brief, page 9, ¶ 1].

The examiner disagrees, again noting that Manchester is relied on as teaching these limitations [answer, page 14].

We find that appellant's arguments misconstrue the term "object" as disclosed by Manchester. We note again that Manchester's invention can sense the physical orientation of "objects" where an "object" to be sensed broadly encompasses not only a display device, but also a person [page 2, ¶0019]. As discussed supra, Manchester explicitly discloses sensor 16 is capable of sensing the orientation of a display device and/or the orientation of a person viewing the display device [¶0021]. Therefore, we find that Manchester teaches automatically orientating rendered graphical objects based at least in part upon a physical orientation of a user with respect to the device, as claimed. We also agree with the examiner that Manchester teaches changing object display parameters to provide at least one of an optimized object display and an optimized viewing position [see e.g., ¶¶ 0019, 0025-0028 and 0035]. For at least the aforementioned reasons, we

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will sustain the examiner's rejection of representative claim 13 as being obvious over Browning in view of Manchester. We further note that appellant has not presented any substantive arguments directed separately to the patentability of dependent claim 14. See In re Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528. See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the examiner's rejection of dependent claim 14 as being obvious over Browning in view of Manchester for the same reasons set forth in the rejection.

**Group D, claim 17**

Lastly, we consider the examiner's rejection of independent claim 17 as being unpatentable over the teachings of Ogawa in view of Manchester.

Appellant argues that Ogawa's digital camera with a self-timer does not teach nor suggest the language of claim 17 that requires "a holder that holds the data capture component at a predetermined position to allow for continuous hands-free capture of data" [brief, page 10]. Appellant further argues that neither Ogawa nor Manchester teaches or suggests the claimed artificial intelligence component that determines an optimal screen orientation for the display based at least upon a user's position [id.].

The examiner disagrees [answer, page 14]. The examiner asserts that Ogawa teaches a self-timer that can be operated in conjunction with a

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continuous shooting mode (col. 5, lines 42-48) [id.]. The examiner further notes that use of Ogawa's self-timer shooting mode reasonably requires a table, tripod, or other holding mechanism to secure the camera [id.].

After carefully reviewing all the evidence before us, we will sustain the examiner's rejection of independent claim 17 for essentially the same reasons argued by the examiner in the answer. We note that the literal term "continuous" is disclosed in the Ogawa reference (i.e., "continuous shooting mode") [col. 5, lines 47 and 54]. We acknowledge that Ogawa does not explicitly indicate whether the self-timer feature operates in conjunction with the continuous shooting mode [see e.g., col. 5, line 54]. Nevertheless, we find the combination of both features is suggested by the reference and would have been an obvious modification to an artisan desiring to shoot a continuous series of frames using a self-timer. We further agree with the examiner that Ogawa's self-timer shooting mode implicitly suggests to an artisan the need for a table, tripod, or other holding mechanism to secure the camera. As to the claimed artificial intelligence component that determines an optimal screen orientation for the display based at least upon a user's position, we find the plain language of the claim broadly but reasonably reads on Manchester's self-orienting display system that performs the recited function, as discussed supra. Accordingly, we agree

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with the examiner that the subject matter of claim 17 is obvious over Ogawa in view of Manchester.

In summary, we have sustained the examiner's rejections of all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**

*Jerry Smith*

JERRY SMITH  
Administrative Patent Judge

*Mahshid D. Saadat*

MAHSHID D. SAADAT  
Administrative Patent Judge

*Allen R. MacDonald*

ALLEN R. MACDONALD  
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